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REMARKS

In the Office Action, the Examiner notes that claims 1-24 are pending in this Application. The Examiner further noted that claims 1-8, 10-18, 22 and 23 are rejected, that claim 9 is objected to and that claims 19-21 and 24 are allowed. By this response, claims 9 and 18 are cancelled and claims 1, 3-4, 6, 10, 12, 14-15 and 22 are amended to correct for informalities pointed out by the Examiner and to more clearly define the invention of the Applicants and not in response to prior art. All other claims continue unamended.

In view of both, the following discussion and the above amendments, the Applicants submit that none of the claims now pending in the application are anticipated under the provisions of 35 U.S.C. §102 or obvious under the provisions of 35 U.S.C. §103. Furthermore, the Applicants also submit that all of these claims now satisfy the requirements of 35 U.S.C. §112. Thus, the Applicants believe that all of these claims are now in allowable form.

OBJECTIONS

The Examiner objected to claims 3-4, 6 and 15 because of the following informalities:

claim 3

The Examiner noted that in claim 3 "voice traffic" seems to refer back to "voice traffic" in line 6 of claim 1.

In response, the Applicants have amended claim 3 to recite "said voice traffic" as suggested by the Examiner.

Having done so, the Applicants respectfully submit that the basis for the Examiner's objection to claim 3 has been removed. As such, the Applicants respectfully request that the Examiner's objection of claim 3 be withdrawn.

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claim 6

The Examiner noted that in claim 6 "signaling traffic" seems to refer back to "signaling traffic" in line 6 of claim 1.

In response, the Applicants have amended claim 6 to recite "said signaling traffic" as suggested by the Examiner.

Having done so, the Applicants respectfully submit that the basis for the Examiner's objection to claim 6 has been removed. As such, the Applicants respectfully request that the Examiner's objection of claim 6 be withdrawn.

claim 15

The Examiner noted that in claim 15 "said voice traffic" seems to refer back to "voice" in line 1 of claim 14.

In response, the Applicants have amended claim 14 to recite "voice traffic" as suggested by the Examiner.

Having done so, the Applicants respectfully submit that the basis for the Examiner's objection to claim 15 has been removed. As such, the Applicants respectfully request that the Examiner's objection of claim 15 be withdrawn.

REJECTIONS

A. 35 U.S.C. § 112

The Examiner rejected claims 4, 10-18 and 22-23 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

claim 4

Regarding claim 4, the Examiner states that claim 4 recites the limitation "said wireless network" in line 3 and that there is insufficient antecedent basis for this limitation in the claim.

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In response, the Applicants have amended claim 4 to recite "wherein said voice traffic is subject to compression processing compatible with said network." The Applicants submit that there is antecedent basis in claim 1 for the limitation of "said network".

Having made this change, the Applicants respectfully submit that the basis for the Examiner's rejection of claim 4 has been removed. As such, the Applicants respectfully request that the Examiner's rejection of claim 4 be withdrawn.

claim 10

Regarding claim 10, the Examiner states that claim 10 recites the limitation "said called party" in line 9 and that there is insufficient antecedent basis for this limitation in the claim.

In response, the Applicants have amended claim 10 to recite "a determination that a called party answers."

Having made this change, the Applicants respectfully submit that the basis for the Examiner's rejection of claim 10 has been removed. As such, the Applicants respectfully request that the Examiner's rejection of claim 10 be withdrawn.

claim 15

Regarding claim 15, the Examiner states that claim 15 recites the limitation "said wireless network" in line 3 and that there is insufficient antecedent basis for this limitation in the claim.

In response, the Applicants have amended claim 15 to recite "wherein said voice traffic is subject to compression processing compatible with said network." The Applicants submit that there is antecedent basis in claim 14 for the limitation of "said network".

Having made this change, the Applicants respectfully submit that the basis for the Examiner's rejection of claim 15 has been removed. As such, the

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Applicants respectfully request that the Examiner's rejection of claim 15 be withdrawn.

claim 18

Regarding claim 18, the Examiner states that claim 18 recites the limitation "said voice traffic" in line 1 and "said signaling traffic" in line 2 and that there is insufficient antecedent basis for these limitations in the claim.

Claim 18 has been cancelled. As such, the Applicants respectfully submit that the basis for the Examiner's rejection of claim 18 has been removed and therefore, respectfully request that the Examiner's rejection of claim 18 be withdrawn.

claim 22

Regarding claim 22, the Examiner states that claim 22 recites the limitation "said memory device" in line 1 and that there is insufficient antecedent basis for this limitation in the claim.

In response, the Applicants have amended claim 22 to depend from claim 21 as suggested by the Examiner.

Having made this change, the Applicants respectfully submit that the basis for the Examiner's rejection of claim 22 has been removed. As such, the Applicants respectfully request that the Examiner's rejection of claim 22 be withdrawn.

Having made the changes described above, the Applicants respectfully submit that claims 4, 10-18 and 22-23, as they now stand, are definite and hence fully satisfy the requirements of 35 U.S.C. § 112.

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B. 35 U.S.C. §102

The Examiner has rejected claims 1-3, 5-6 and 10-14 under 35 U.S.C. § 102(e) as being anticipated by Nabkel et al. (U.S. Patent No. 6,584,184, hereinafter "Nabkel"). The rejection is respectfully traversed.

The Examiner alleges that regarding claims 1-3, 10 and 13-14, Nabkel discloses an apparatus for providing bifurcated voice and signaling data over a network comprising a memory for storing protocols for interfacing with the network and a processor for segregating signaling traffic and related voice traffic including information useful in establishing a communication link for transporting the voice between a calling party and a called party, and for transmitting the voice traffic and signaling traffic via different communications channels, wherein one of the communications channels is a data packet network and wherein voice traffic is carried by the data packet network. The Applicants respectfully disagree.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984) (citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983)) (emphasis added).

The Applicants respectfully submit that Nabkel fails to disclose each and every element of the claimed invention, as arranged in at least the Applicants' new amended claim 1, which specifically recites:

"An apparatus for providing bifurcated voice and signaling data over a network, comprising:

a memory, for storing protocols for interfacing with the network; and
a processor, coupled to said memory, for segregating signaling traffic and related voice traffic including information useful in establishing a communications link, for transporting said voice traffic between a calling party and called party, and for transmitting said voice traffic and said

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signaling traffic via different communication channels, wherein said voice traffic is switched to the same communication channel as said signaling traffic in the case of a loss of local power." (emphasis added)

In support of at least amended claim 1 as depicted above, the Applicants, in the specification, specifically recite:

"It will be appreciated by those skilled in the art that first MTA-CT 106 will transmit voice in compressed form via first cable modem 108 based upon the wireless technology used. Since first switch 128 is a wireless switch, wireless voice compression techniques can be utilized between first MTA-CT 106 and first switch 128. In case local power is lost to first MTA-CT 106, the voice traffic is transmitted over the wireless network." (See Specification, page 7, lines 8-15).

As evident from the Applicants' disclosure (at least the sections provided above) and the Applicants' claims, it is clear that in the invention of the Applicants, during a loss of local power, voice traffic is switched to the same communication channel as signaling traffic. The Applicants disclose techniques and apparatuses for detecting the loss of local power and in response switching voice traffic to the same communication channel as signaling traffic.

In contrast to the invention of the Applicant, there is absolutely no teaching, suggestion or disclosure in Nabkel for an apparatus for providing bifurcated voice and signaling data over a network "wherein said voice traffic is switched to the same communication channel as said signaling traffic in the case of a loss of local power" as taught in the Applicants' Specification and claimed by at least the Applicants' claim 1.

Furthermore, in the Office Action the Examiner noted that claim 9 would be allowable over the cited references if written in independent form to include all of the limitations of the base claim and any intervening claims. The Applicants' new amended claim 1 now includes all of the limitations of claim 9 and as conceded by the Examiner, is now in allowable form.

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As conceded by the Examiner, the Applicants respectfully submit that Nabkel fails to teach each and every element of the Applicants' new amended claim 1, which includes all of the limitations of the Applicant's former claim 9, which was considered by the Examiner as allowable over the cited references if rewritten in independent form including all of the limitations of the base claim (Claim 1). More specifically, Nabkel fails to teach, suggest or disclose at least an apparatus for providing bifurcated voice and signaling data over a network "wherein said voice traffic is switched to the same communication channel as said signaling traffic in the case of a loss of local power" as taught in the Applicants' Specification and claimed by at least the Applicants' claim 1.

Therefore, the Applicants submit that independent claim 1 is not anticipated by the teachings of Nabkel and, as such, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

Likewise, independent claim 10 recites similar relevant features as recited in independent claim 1. As such, the Applicants submit that independent claim 10 is also not anticipated by the teachings of Nabkel and also fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

Furthermore, dependent claims 2-3, 5-6 and 11-14 depend either directly or indirectly from independent claims 1 and 10 and recite additional features therefor. As such and for at least the reasons set forth herein, the Applicants submit that dependent claims 2-3, 5-6 and 11-14 are also not anticipated by the teachings of Nabkel. Therefore the Applicants submit that dependent claims 2-3, 5-6 and 11-14 also fully satisfy the requirements of 35 U.S.C. § 102 and are patentable thereunder.

The Applicants reserve the right to establish the patentability of each of the claims independently in subsequent prosecution.

Even further and with respect to claim 10, in the Office Action the Examiner noted that claim 18 would be allowable over the cited references if written in independent form to include all of the limitations of the base claim and any intervening claims. The Applicants' new amended claim 10 now includes all

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of the limitations of claim 18 and as conceded by the Examiner, is now in allowable form.

As conceded by the Examiner, the Applicants respectfully submit that Nabkel fails to teach each and every element of the Applicants' new amended claim 18, which includes all of the limitations of the Applicant's former claim 18, which was considered by the Examiner as allowable over the cited references if rewritten in independent form including all of the limitations of the base claim (Claim 10). More specifically, Nabkel fails to teach, suggest or disclose at least an apparatus for providing bifurcated voice and signaling data over a network "wherein voice traffic is switched to the same communication channel as signaling traffic in the case of a loss of local power" as taught in the Applicants' Specification and claimed by at least the Applicants' claim 10.

C. 35 U.S.C. §103

The Examiner rejected claims 4 and 15 under 35 U.S.C. §103(a) as being unpatentable over Nabkel in view of La Medica Jr. et al. (U.S. Patent No. 6,625,451, hereinafter "LaMedica"). The rejection is respectfully traversed.

Claims 4 and 15 depend from independent claims 1 and 10 and recite additional feature thereof. The Examiner applied Nabkel to claims 4 and 15 as applied above for his rejection of claims 1 and 10.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 U.S.P.Q. 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added).

As recited above and as conceded by the Examiner, Nabkel fails to teach, suggest or disclose at least an apparatus for providing bifurcated voice and

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signaling data over a network "wherein voice traffic is switched to the same communication channel as signaling traffic in the case of a loss of local power" as taught in the Applicants' Specification and claimed by at least the Applicants' claims 1 and 10. Therefore, at least because the teachings of Nabkel do not suggest, teach or describe the invention of the Applicants regarding claims 1 and 10, the Applicants respectfully submit that the teachings of Nabkel also do not teach, suggest, or describe the invention of the Applicants regarding dependent claims 4 and 15 and do not render the Applicants' claims 4 and 15 obvious.

In addition and as conceded by the Examiner, the Applicants respectfully submits that the teachings of La Medica also do not suggest, teach or describe the Applicant's invention at least with regard to claims 1 and 10. In particular, La Medica merely discloses a preferred roaming list and system select feature where a System Select feature provides user selectable modes of operation in a mobile communication station, which allow certain fall-back options when a preferred system may not be available, but still steers the bulk of the system selection operations to preferred systems. The Examiner recites La Medica for teaching compression comparable with a wireless network. However, there is absolutely no teaching, suggestion or disclosure in La Medica for an apparatus for providing bifurcated voice and signaling data over a network "wherein voice traffic is switched to the same communication channel as signaling traffic in the case of a loss of local power" as taught in the Applicants' Specification and claimed by at least the Applicants' claims 1 and 10. Therefore, at least because the teachings of La Medica do not suggest, teach or describe the invention of the Applicants regarding claims 1 and 10, the Applicants respectfully submit that the teachings of La Medica also do not teach, suggest, or describe the invention of the Applicants regarding dependent claims 4 and 15 and do not render the Applicants' claims 4 and 15 obvious.

The Applicants further submits that there is no suggestion or motivation to combine the teachings of Nabkel and La Medica in an attempt to teach the invention of the Applicants.

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For prior art reference to be combined to render obvious a subsequent invention under 35 U.S.C. § 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. Uniroyal v. Rudkin-Wiley, 5 U.S.P.SQ.2d 1434, 1438 (Fed. Cir. 1988). The teachings of the references can be combined only if there is some suggestion or incentive in the prior art to do so. In re Fine, 5 U.S.P.SQ.2d 1596, 1599 (Fed. Cir. 1988). Hindsight is strictly forbidden. It is impermissible to use the claims as a framework to pick and choose among individual references to recreate the claimed invention Id. at 1600; W.L. Gore Associates, Inc., v. Garlock, Inc., 220 U.S.P.Q. 303, 312 (Fed. Cir. 1983).

Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

The Applicants further submit that even if there was a motivation or suggestion to combine the references (which the Applicants believe that there is none), the teachings of the La Medica fail to bridge the substantial gap between the Nabkel reference and the Applicants' invention at least with respect to claims 1 and 10. Again, there is absolutely no teaching, suggestion or disclosure in Nabkel or La Medica, alone or in any allowable combination for an apparatus for providing bifurcated voice and signaling data over a network "wherein voice traffic is switched to the same communication channel as signaling traffic in the case of a loss of local power" as taught in the Applicants' Specification and claimed by at least the Applicants' claims 1 and 10.

Therefore, at least because the teachings of Nabkel and La Medica, alone or in any allowable combination, do not teach, suggest, or describe the invention of the Applicants regarding at least claims 1 and 10 as discussed above, the Applicants respectfully submit that the teachings of Nabkel and La Medica, alone or in any allowable combination, also do not teach, suggest, or describe the

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invention of the Applicants regarding claims 4 and 15, which depend indirectly from independent claims 1 and 10, and do not render the Applicants' claims 4 and 15 obvious.

As such, the Applicants submit that claims 4 and 15, as they now stand, are not obvious and fully satisfy the requirements under 35 U.S.C. §103 and are patentable thereunder.

The Applicants reserve the right to establish the patentability of each of the claims independently in subsequent prosecution.

D. 35 U.S.C. §103

The Examiner rejected claims 7-8 and 16-17 under 35 U.S.C. §103(a) as being unpatentable over Nabkel in view of La Medica Jr. et al. (U.S. Patent No. 6,625,451, hereinafter "LaMedica"). The rejection is respectfully traversed.

Claims 7-8 and 16-17 depend from independent claims 1 and 10 and recite additional feature thereof. The Examiner applied Nabkel to claims 7-8 and 16-17 as applied above for his rejection of claims 1 and 10.

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 U.S.P.Q. 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added).

As recited above and as conceded by the Examiner, Nabkel fails to teach, suggest or disclose at least an apparatus for providing bifurcated voice and signaling data over a network "wherein voice traffic is switched to the same communication channel as signaling traffic in the case of a loss of local power" as taught in the Applicants' Specification and claimed by at least the Applicants' claims 1 and 10. Therefore, at least because the teachings of Nabkel do not

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suggest, teach or describe the invention of the Applicants regarding claims 1 and 10, the Applicants respectfully submit that the teachings of Nabkel also do not teach, suggest, or describe the invention of the Applicants regarding dependent claims 7-8 and 16-17 and do not render the Applicants' claims 7-8 and 16-17 obvious.

In addition and as conceded by the Examiner, the Applicants respectfully submits that the teachings of La Medica also do not suggest, teach or describe the Applicant's invention at least with regard to claims 1 and 10. In particular, La Medica merely discloses a preferred roaming list and system select feature where a System Select feature provides user selectable modes of operation in a mobile communication station, which allow certain fall-back options when a preferred system may not be available, but still steers the bulk of the system selection operations to preferred systems. The Examiner recites La Medica for teaching compression comparable with a wireless network. However, there is absolutely no teaching, suggestion or disclosure in La Medica for an apparatus for providing bifurcated voice and signaling data over a network "wherein voice traffic is switched to the same communication channel as signaling traffic in the case of a loss of local power" as taught in the Applicants' Specification and claimed by at least the Applicants' claims 1 and 10. Therefore, at least because the teachings of La Medica do not suggest, teach or describe the invention of the Applicants regarding claims 1 and 10, the Applicants respectfully submit that the teachings of La Medica also do not teach, suggest, or describe the invention of the Applicants regarding dependent claims 4 and 15 and do not render the Applicants' claims 7-8 and 16-17 obvious.

The Applicants further submits that there is no suggestion or motivation to combine the teachings of Nabkel and La Medica in an attempt to teach the invention of the Applicants.

The Applicants further submit that even if there was a motivation or suggestion to combine the references (which the Applicants believe that there is none), the teachings of the La Medica fail to bridge the substantial gap between

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the Nabkel reference and the Applicants' invention at least with respect to claims 1 and 10. Again, there is absolutely no teaching, suggestion or disclosure in Nabkel or La Medica, alone or in any allowable combination for an apparatus for providing bifurcated voice and signaling data over a network "wherein voice traffic is switched to the same communication channel as signaling traffic in the case of a loss of local power" as taught in the Applicants' Specification and claimed by at least the Applicants' claims 1 and 10.

Therefore, at least because the teachings of Nabkel and La Medica, alone or in any allowable combination, do not teach, suggest, or describe the invention of the Applicants regarding at least claims 1 and 10 as discussed above, the Applicants respectfully submit that the teachings of Nabkel and La Medica, alone or in any allowable combination, also do not teach, suggest, or describe the invention of the Applicants regarding claims 7-8 and 16-17, which depend indirectly from independent claims 1 and 10, and do not render the Applicants' claims 7-8 and 16-17 obvious.

As such, the Applicants submit that claims 7-8 and 16-17, as they now stand, are not obvious and fully satisfy the requirements under 35 U.S.C. §103 and are patentable thereunder.

The Applicants reserve the right to establish the patentability of each of the claims independently in subsequent prosecution.

Applicants' Note

The Applicants would like to thank the Examiner for pointing out allowable subject matter, however, the Applicants respectfully submit that, as they now stand, all of the Applicants' claims are allowable over the prior art cited by the Examiner. The Applicants do agree with the Examiner, however, that claims 9 and 18 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and that claims 19-21 and 24 are allowable as they stand.

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CONCLUSION

Thus, the Applicants submit that none of the claims presently in the application are anticipated under the provisions of 35 U.S.C. § 102 or obvious under the provisions of 35 U.S.C. § 103. Furthermore, the Applicants also submit that all of these claims now satisfy the requirements of 35 U.S.C. §112. Consequently, the Applicants believe that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse action in any of the claims now pending in the application, it is requested that the Examiner telephone Mr. Jorge Tony Villabon at (732) 530-9404 x1131 or Mr. Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

4/27/04



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